

TABLE I	
Summary of the results of the experiments	
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

No. —.

ERVIN HOWELL and RAYMOND EARL GUTERMUTH, *Petitioners*
and *Appellants below*,

v.

ROYDEN O. COUCH, Doing Business as COUCH MANUFACTUR-
ING COMPANY, *Respondent and Appellee below*.

**BRIEF IN SUPPORT OF PETITION FOR
WRIT OF CERTIORARI.**

OPINIONS OF THE COURTS BELOW.

The findings of fact and conclusions of law of the District Court for the Southern District of Florida are reported in 49 U. S. Pat. Quart. 595 and will be found beginning at page 178 of the record.

The opinion of the Fifth Circuit Court of Appeals is reported in 127 Fed. (2nd) 975 and in 53 U. S. Pat. Quart. 531, and will also be found beginning at page 336 of the record.

JURISDICTION.

The grounds on which jurisdiction vests are set out in the petition at pages 5 & 6, and to avoid duplication are not repeated in this brief.

STATEMENT OF THE CASE.

The facts have been sufficiently stated in the preceding petition (pp. 2 to 5) and that statement is hereby adopted and made a part of this brief by reference.

SPECIFICATION OF ERRORS.

In the event of granting this application for a writ of certiorari, your Petitioners will urge that the Fifth Circuit Court of Appeals erred:

1. In holding the claims in suit as defining patentable invention over the public use testified to by Anderson.
2. In holding the claims in suit valid as representing patentable invention over the patents to Gill (R. 310, Figs. 24 or 33) and Grunow (R. 326, Figs. 7 & 9) either singly, or the one as modified by the other.
3. In so applying the doctrine of equivalents as to make the flashboards used by your Petitioners the mechanical equivalents of the gates prescribed by Respondent's patent claims.
4. In holding claim 2 infringed by so far disregarding the expression, "a transverse diaphragm substantially the intermediate ends thereof, the opening in which communicates with the walls of said conduit" as to have it comprehend the deck or supporting shelf on which your Petitioners mount their pump unit, thereby ignoring the rule that an originally incorporated limitation in a claim must be construed against the patentee and in favor of the public and treated in the nature of a disclaimer.

5. In holding claim 2 infringed by ignoring the limitation, "said housing having a plurality of angularly disposed inlet and discharge openings below and above said diaphragm," thus ruling that the space between the parallel walls at the opposite ends thereof falls within the compass of such description and thereby failing to apply the rule of disclaimer by amendment.

6. In treating the Anderson testimony as insufficient to show that the construction made and used by your Petitioners was old, prior to the Respondent's date of invention.

7. In finding that the Respondent had made a practical advance and resolving their expressed doubt on the validity of the claim in his favor when that practical advance had to be determined from the testimony of two witnesses who gave only opinion evidence which is not clear as to whether the so-called practical advance was due to the combination of elements or to the efficiency of the admittedly unpatented pump unit.

ARGUMENT

Summary of Argument.

The points of argument follow the reasons relied upon for the grant of a writ of certiorari and, being stated in the index and on page 8 of the petition, are omitted at this point in the interest of brevity and to avoid duplication.

POINT A.

The Court of Appeals for the Fifth Circuit has sustained as valid and infringed a patent which has not heretofore been litigated but which, by reason of the decision, will now dominate an entire industry confined wholly within the State of Florida, thus making improbable any future litigation involving the patent before any other federal court of equal dignity.

The entire industry in pumps employed for use in irrigation and drainage canals such as are used for farming

purposes in the Southern portion of the State of Florida is concentrated within said State. (R. 33, 34, 42 & 45 and the affidavit of your Petitioner, Howell, p. 10 hereof)

Respondent, while having a patent which does not purport to comprehend more than a specific form of pump apparatus having a plurality of independently controlled inlets and outlets, has urged it successfully in the trial court and apparently in the appellate court as a patent covering the so-called reverse flow whereby the device may be installed in a drainage canal and employed to raise and lower the water level at either side of the installation. While the trial court found all of the claims in issue to be valid and infringed, the decision of that court was reversed with respect to claims 1 and 4 but affirmed as to claim 2 because the appellate court saw breadth in that claim while expressing difficulty in sustaining it in view of the prior art. The decision of the appellate court will give the Respondent practical control of the irrigating pump industry which is confined to the State of Florida and will enable him to extract tribute from users on any basis which he sees fit. Your Petitioners built and sold the so-called two-way pump for prices that would yield them a reasonable profit, but such prices, according to the Respondent, were considerably below his standard prices and had a tendency to "cause an unnecessary sales resistance". (R. 295 & 296)

Since the use of the invention is confined wholly within the State of Florida and since the so-called reverse flow is a general plan for drainage and irrigation, the effect of the decision of the Court of Appeals is to give the Respondent domination of an entire industry. In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, this Court held that notwithstanding the doubtful validity of the patent, litigation elsewhere with resulting conflict of decision was improbable because of the concentration (in that particular case) of the (automobile) industry in the Sixth Circuit, citing *Paramount Public Corp v. American Tri-Ergon Corp.*,

294 U. S. 464, and *Altoona Publix Theatres, Inc., v. American Tri-Ergon Corp.*, 294 U. S. 477, and granted the writ.

The same reason influenced the granting of writs of certiorari, in the 1941 term, in *Chicago Coin Machine Co. v. Ace Patents Corp.*, 315 U. S. ; 62 Sup. Ct. Rep. 513; and *Muncie Gear Works v. Outboard Marine and Manufacturing Co.*, U. S. ; 62 Sup. Ct. Rep. 865.

POINT B.

The Court of Appeals for the Fifth Circuit has sustained the validity of the claims in suit on the presumption of the validity attaching to the patent grant and on doubtful proof of the commercial success of the patented invention when the only difference over an old device is the provision of a plurality of selectively controlled inlets in place of one and in so doing has rejected this Court's criterion of patentable invention and has, therefore, rendered a decision in conflict with applicable decisions of this Court.

The sole differentiating features in Respondent's patent over the prior art devices, as exemplified by the patents to Gill (R. 310, Figs. 24 & 33) and Grunow, (R. 326, Figs. 7 & 9) are the diaphragm which communicates with the draft and discharge conduit, the cylindrical outer casing with which the diaphragm connects, the plurality of angularly related orifices in the outer casing and the vertically adjustable gates for each slidable in guide grooves above and below the diaphragm.

The diaphragm construction differs from the construction shown in the patent to Grunow only in being an expanded portion of the upper end of the intake and discharge conduit rather than a shelf or platform supporting the pump unit. The outer casing differs from the penstock of Grunow only in being a cylindrical steel shell rather than a square or rectangular wood structure. The orifice arrangement differs from Figure 7 of Grunow only in having a plurality of openings below the platform but does not differ from Gill in this respect. And the gate construction differs

from Grunow only in having the gates mounted in guide grooves which extend above and below the diaphragm.

These differentiating features are of so inconsequential a nature that they are well within the province of the average mechanic. And on this basis they do not rise to the dignity of patentable novelty and, if not, the patent is void.

As was said by this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. ; 62 Sup. Ct. Rep. 40, "We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. Under the statute, the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. Since *Hotchkiss v. Greenwood*, 11 How. 248, it has been recognized that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the work of a mechanic skilled in the art". (Citing authorities)

Inventive genius is not required to apply a plurality of gate controlled inlets below the pump platform of Figure 7 of the patent to Grunow, or to duplicate the inlet and outlet of the structure of Figure 9 thereof, and doing this, every material and substantial part of the patented invention will be present.

Alleged commercial success apparently influenced the Court of Appeals to sustain the validity of the claims but, as shown in the argument under Point C, what commercial success was attained was not due to the construction which the patent purportedly covers. (Specially concurring opinion of Chief Justice Stone in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. ; 62 Sup. Ct. Rep. 41.)

POINT C.

The Court of Appeals for the Fifth Circuit, in sustaining infringement of claim 2 and in regarding it as having breadth, has rendered a decision so applying the doctrine of equivalents and the rule of disclaimer by amendment and originally incorporated limitations that such decision is in conflict with applicable decisions of this Court.

In finding claim 2 infringed the Court of Appeals must necessarily have concluded that the diaphragm prescribed by the claim is like or equivalent to the pump supporting shelf of your Petitioners. The expression "a transvers diaphragm substantially intermediate the ends thereof, the opening in which communicates with the walls of said conduit" definitely positions the diaphragm at the upper end of the draft and discharge conduit. This awkward and cryptic expression has been in the claims since the inception of the application on which the patent was granted. The diaphragm (R. 216) is an integral part of the draft and discharge conduit and has no defined opening. The term "opening" as used in the claim certainly can not mean such an opening as that in the deck on which your Petitioner's pump is disposed (R. 298) because it would then be specific to your Petitioner's construction, whereas it was drawn with a specifically different construction as a basis. It could only comprehend the construction shown in the patent and your Petitioners' construction by being generic to the two. Something which is intangible, as an opening, can not communicate with something which is tangible, as a wall, no matter how loose a meaning be given to the word "communicating".

The only logical interpretation of the expression is that the bore of the conduit opens through the diaphragm which means that the diaphragm is at the upper end of the conduit.

After persistent rejection by the Examiner, it was argued on behalf of the Respondent (R. 275, 2nd par.): **"It appears that none of the references include the diaphragm**

forming an expanded portion of the inlet and outlet conduit as illustrated, described and claimed by this applicant". But before the Respondent's attorneys undertook a translation of this expression and before this differentiating feature was urged, the Examiner indicated his understanding of the expression (R. 269, last 2 sentences) as meaning that the diaphragm is at the upper end of the conduit.

Claim 2 also prescribes a "plurality of angularly disposed" openings below and above the diaphragm and it is evident from the prosecution of the application that the Respondent laid great stress on the angularly related orifices and the gate for each, for in the remarks of Amendment C, (R. 279, last par.) he says:

"As now stated in the claim, the present applicant has provided a long housing which has a diaphragm across the interior thereof intermediate its ends, the housing being provided with openings above and below the diaphragm so that water may pass through the inner conduit. These openings are each closed or opened independently by means of slidable gates which are carried partly on the lower part of the housing and partly on the extension above the diaphragm, the extension above the diaphragm forming guides whereby the vertically slidable gates are held in position."

And in Amendment B, (R. 274, last par.) the Respondent says:

"Furthermore, applicant's arrangement allows the water to be drawn in around any portion of the entire circumference of the outer casing, and allows it to be discharged at any portion of the entire circumference of the outlet portion of the casing, by simply manipulating the necessary vertically adjustable gates".

Because, in your Petitioners' construction when installed, the water passes between the two masonry walls at one side, up through the pump and out between the walls at the other side, the Respondent has successfully contended below that there is present a casing with a plurality of angularly re-

lated orifices since there is more than one point of entrance for the water and these points are disposed 180° apart. (R. 89) If the term "angularly related" as used in the claims of the patent means anything, it means an angular relation less than 180° for in the patented construction the angularly related orifices are provided for changing the water level on either side of the pump in either or both of two intersecting canals. The description of the relative positions of the openings in terms of angular measurement may be proper in the patent because of the structure illustrated but there is no warrant for applying that system to indicate the relative positions of the ends of the walls of your Petitioner's foundation.

There are copious decisions of this Court which have applied the rule that limitations and provisos, imposed by the inventor, especially such as were introduced into the application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public and looked upon in the nature of disclaimers. *Leggett v. Avery*, 101 U. S. 256; *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222; *Fay v. Cordesman*, 109 U. S. 408; *Mahn v. Harwood*, 112 U. S. 354; *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S. 624; *Sargent v. Hall Safe Etc. Co.*, 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *White v. Dunbar*, 119 U. S. 47; *Sutter v. Robinson*, 119 U. S. 530; *Bragg v. Fitch*, 121 U. S. 478; *Snow v. Lake Shore, Etc. R. Co.*, 121 U. S. 617; *Hubbell v. United States*, 179 U. S. 77; *Coupe v. Royer*, 155 U. S. 565; *Crawford v. Heysinger*, 123 U. S. 589; *Thompson v. Boisselier*, 114 U. S. 1; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429.

Also this Court has reiterated the rule that where a patentee has narrowed his claim to obtain the patent, he may not thereafter, by construction or by resort to the doctrine of equivalents, give the claim the larger scope which it might have had without the amendments amounting to a disclaimer. *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S.

429; *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U. S. 668; *Smith v. Magic City Kennel Club*, 282 U. S. 784.

Again this Court has said that claims can not be construed to include more than their language fairly imports, even though the patentee may have been unfortunate in his selection of words and have been entitled to broader claims. *McClain v. Ortmyer*, 141 U. S. 419.

In finding the flashboards used by your Petitioners to be the mechanical equivalents of the slidable gates prescribed by the Respondent's patent, the appellate court has made a loose application of the doctrine of equivalents. In the patent the gate controlled discharge openings are fixed and the plane of their lower edges never changes. With flashboards the discharge openings, in effect, change in position with the adjustment of the flash boards, the plane of the lower edge of either discharge opening being determined by the uppermost flash board. The Respondent at pages 40 and 41 of the record testified to certain advantages flowing from the use of flashboards and these advantages are not possible of accomplishment in the patented construction.

POINT D.

The Court of Appeals for the Fifth Circuit, in refusing to give weight to the public use testified to by Anderson because it rests on his sole testimony as to the time when he had tangible evidence to support his date, as well as what he had at that date and when the trial court found it necessary to make a finding of fact giving the Respondent an earlier date, has rendered a decision in direct conflict with applicable decisions of this Court.

Prior knowledge and use by a single person will suffice to void a patent, the number is immaterial. *Egbert v. Lippman*, 104 U. S. 333; *Hall v. Macneale*, 107 U. S. 90; *Alexander Millburn Co. v. Davis-Bournonville Company*, 270 U. S. 390.

If the patentee is not the first inventor his patent is void. This Court has reiterated that proposition at brief inter-

vals for over a hundred years. Your Petitioner's construction is identical with that used by Anderson and if the former is comprehended by the Respondent's patent, the patent is invalid by reason of Anderson's prior use.

While Anderson is the only witness as to what was done in 1929, that fact is not fatal if Anderson can definitely establish the date and what he had on that date. There is no rule or law requiring the rejection of the testimony of a lone witness and it is sufficient, on definitely establishing facts to prove anticipation. *Corona Cord Tire Co. v. Dovan Chemical Corp.*, 276 U. S. 358.

In the reported case, proof of prior reduction to practice, both as to time and form, lay in the testimony of the lone witness, Kratz, who said that he had told no one of the fact but that he had vulcanized three hundred tubes of a thousand tube order, using the patented process for the purpose.

The finding of fact in the trial court with respect to Anderson seeks to make it appear that it was uncertain what he had despite the fact that he produced a large working model to illustrate the form and a ledger sheet of the transaction with the Primola Farms to determine the date. (R. 141 and 293 and illustration opposite page 10.) And despite the fact that Respondent was given the opportunity, without objection, of rebutting the Anderson testimony, the finding concludes with the statement that the Primola installation constituted "nothing more than an abandoned experiment", when Anderson had nothing to abandon since it was not his invention. (R. 186, 136, 139, and 292) There is no reason behind the conclusion that the Primola Farms installation was an "abandoned experiment" unless the date be admitted as established.

The finding of fact (R. 183, No. 5) which gives the Respondent a disclosure date in the early summer of 1929 is a tacit admission that the date Anderson testified to is established. Otherwise there is no occasion for establishing any dates for the Respondent prior to the date of his application for patent. Yet the 1929 disclosure date is accorded him

on his own testimony alone, unsupported by documentary or other evidence and when it was given in rebuttal and is prior to the date testified to in his testimony-in-chief. (R. 34, line 21)

The construction installed by your Petitioners is a "chinese copy" of the Anderson model and if that and the ledger sheet be proof of the form and date of the Primola Farms installation, as they certainly are, your Petitioners are shown to be non-infringers regardless of any other considerations.

CONCLUSION.

Wherefore, your Petitioners respectfully submit that this application for a writ of certiorari should be granted and that the decision of the United States Circuit Court of Appeals for the Fifth Circuit, should upon review, be reversed.

FRANCIS G. BOSWELL,
Counsel for Petitioners.

